

Appl. No. 09/851,066
Amdt. dated February 1, 2006
Reply to Office action of November 1, 2005

REMARKS/ARGUMENTS

Applicants received the Office action dated November 1, 2005, in which the Examiner: 1) rejected claims 1 and 22 under 35 U.S.C. § 101; 2) rejected claims 1-6, 8-13, 15-20 and 22 under 35 U.S.C. § 102(e) as being anticipated by Hadzikadic (U.S. Pub. No. 2002/0059202, hereinafter "*Hadzikadic*"); and 3) rejected claims 7, 14 and 21 under 35 U.S.C. § 103(a) as obvious over Hadzikadic in view of Gehrke (Tutorial notes of the fifth ACM SIGKDD international conference on Knowledge discovery and data mining, hereinafter "*Gehrke*"). Based on the arguments below, Applicants believe all claims to be in condition for allowance.

In the § 101 rejections, the Examiner contends that claims 1 and 22 are not directed to statutory subject matter because the claimed method actions could be performed by a human being. A rejection under this basis is improper per the Office's own examination guidelines. Annex III of the "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" states that the "mental step or human step tests" "are not to be applied by examiners in determining whether the claimed invention is patent eligible subject matter." Annex III (emphasis in original). Applicants respectfully request the Examiner to withdraw the § 101 rejections.

Annex III further states that "[I]f all the steps of a claimed process can be carried out in the human mind, examiners must determine whether the claimed process produces a useful, tangible, and concrete result, i.e., apply the practice application test set forth in State Street." Annex III(c)(i). This statement acknowledges that method claims can be statutory even if performable by human mental actions. Further, claims 1 and 22 include actions that classify a record. Classifying a record is "a useful, concrete, and tangible result." See *State Street Bank & Trust Co. v. Signature Financial*, 149 F.3d 1368, 1373 (Fed. Cir. 1998). Also, references in claims 1 and 22 to the first and second "classification tools (trees)" also impart statutory subject matter to claims 1 and 22.

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Applicants are shocked that the Examiner now largely relies on Hadzikadic because the Examiner used the Hadzikadic reference almost two years ago to reject the then-pending claims. See Office action of January 30, 2004. Following a response to the January 2004 Office action, the Examiner evidently was convinced of the patentability of the claims over Hadzikadic, but used other references to continue rejecting the claims. The Examiner seems to have come full circle and has repeated a rejection that was addressed about two years ago. At any rate, Applicants offer the following reasons why the pending claims are allowable over Hadzikadic.

Claim 1 requires using one of a first and a second classification tool depending on the completeness of the record being classified. Hadzikadic only describes the development of a classification tool or classification tree. In general, Hadzikadic described a process in which "instances" to be classified are received and added to a tree in order to build the tree. Para. [0077] (referencing a classification tree building process). Applicants respectfully submit that Hadzikadic does not teach the use of a classification tree to classify a record. Whereas, Hadzikadic takes data and builds a classification tree, the invention of claim 1 applies classification tools to classify data.

Hadzikadic also does not teach use of one classification tool instead of another. Further, Hadzikadic does not show or suggest a criterion for deciding when one of the classification tools is used instead of the other.

Hadzikadic also does not address the situation in which the instance of information to be classified is incomplete. The Examiner refers to Hadzikadic's references to 75% and 85%, para. [0025], for this claimed feature, but Applicants respectfully submit that the Examiner is mistaken. Those percentages do not refer to the completeness of the data in a record to be classified, but rather to a confidence level of a resulting classification structure.

For any or all of these reasons, claim 1 is allowable over Hadzikadic. No other art of record satisfies the deficiencies of Hadzikadic. For at least the same reasons, all claims dependent on claim 1 are also allowable. All other claims are

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allowable over Hadzikadic for the same or similar reasons as those expressed above.

In the course of the foregoing discussions, Applicants may have at times referred to claim limitations in shorthand fashion, or may have focused on a particular claim element. This discussion should not be interpreted to mean that the other limitations can be ignored or dismissed. The claims must be viewed as a whole, and each limitation of the claims must be considered when determining the patentability of the claims. Moreover, it should be understood that there may be other distinctions between the claims and the cited art which have yet to be raised, but which may be raised in the future.

Applicants respectfully request reconsideration and that a timely Notice of Allowance be issued in this case. It is believed that no extensions of time or fees are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required (including fees for net addition of claims) are hereby authorized to be charged to Hewlett-Packard Development Company's Deposit Account No. 08-2025.

Respectfully submitted,



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